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| 09/839,241 | 04/23/2001 | Robert Krause | 08049.0765 | 4011 | | |
| 22852 | 7590 | 10/23/2009 | EXAMINER | | | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | | ELISCA, PIERRE E | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/839,241 | KRAUSE ET AL. | |
| | Examiner | Art Unit | |
| | Pierre E. Elisca | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 September 2009.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 4-20,55-64,66-80,115-122,126-142 and 177-184 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 4-20,55-64,66-80,115-122,126-142 and 177-184 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION

1. This office action is in response to Applicant's RCE filed on 09/30/2009.
2. Claims 4-20, 55-64, 66-80, 115-122, 126-142 and 177-184 are currently pending.

Claim Rejections - 35 USC § 112 - 2nd Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 4, 6, 14, 55 and 177 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite because they are considered hybrid claims. See MPEP 2173.05 (p) II. In particular, the claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. 101.

For example, claims 4, 6, 14, 55 and 177 recite "a method for providing an electronic change". In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicant (s) to claim a product claim. Alternatively, claims 4, 6, 14, 55 and 177 recite "**a service unit**". One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claims 4, 6, 14, 55 and 177 to be drawn to both a product or process.

Therefore in accordance with MPEP §2173.05 (p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession* alone of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite.

Claims 126, 130, 136 and 177 are also rejected under 35 USC 112 second paragraph because it recites “program code for” which is not performing any function and can be regarded as intended use. Applicant is advised to remove the word “for”. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 128, 130, 136 and 177 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter. Specifically the claim is directed towards an abstract idea.

Claims 128, 130, 136 and 177 recite “a computer program product being stored on a computer-readable medium”. “Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical ‘things.’ They are neither computer components nor statutory processes, as they are not ‘acts’ being

performed." MPEP §2106.01 I. Using the broadest reasonable interpretation, a "unit" is interpreted as software alone. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention.¹ Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101. **Applicant is advised to amend the claims as follows: --a computer program product being stored on a computer-readable medium, when executed by the computer to perform---**

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 4-20, 55-64, 66-80, 115-122, 126-142 and 177-184 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Tsuei (U.S. Patent No. 6,654,779) in view of Hossain, K. Omar et al. (U.S. Pat. No. 5,581,749).

As per claim 4, Tsuei substantially teaches a method for providing an electronic change of address service from an old address of a customer to a new address of the

¹ 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" (or products) while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed).

customer, comprising: providing a user interface at a change of address server for the customer to enter change of address information; receiving the change of address information at the change of address server via a network; creating a first change of address record at the change of address server representing the change of address information; validating an identity of the customer at the change of address server; electronically transferring the first change of address record to a service center when the identity is valid, creating a second change of address record at the service center by modifying the first change of address record received from the change of address server; forwarding the second change of address record electronically from the service center to a forwarding service unit corresponding to the old address of the customer at least one of the sub-services within the change of address service, and processing, by the forwarding service unit, the second change of address record received from the service center electronically to automatically redirect mail addressed to the old address of the customer to the new address of the customer (see col. 3 lines 1-65, 5 lines 10-54, 6 lines 6-7 line 52).

Tsuei fails to explicitly disclose Applicant's newly added limitation an old physical address to a new physical address. Hossain discloses a creation of a new customer logical record involves the creation of a customer physical record, the creation of an address physical record and creation of a new customer-address record (see., abstract, detailed description text, items 2014, 2016, 2018 and 2020, col 1- col 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic change of address of Tsuei by including the limitation

detailed above as taught by Hossain because this would update or delete the reference record on the global codes database and by distributing the update or delete to the transaction processing systems which had been instructed to create the record.

As per claims 6, 8, 14, 55, 63, 66, 68, 74, 115, 126, 128, 130, 136, and 177, Tsuei discloses the claimed limitations of providing a user interface at a change of address server for the customer to enter change of address information, receiving the change of address information at the change of address server via a network, creating a first change of address record at the change of address server based on the change of address information, validating an identity of the customer at the change of address server, creating a second change of address record using information from the first change of address record received from the change of address server, when the identity is valid, and processing, by a forwarding service unit, the second change of address record electronically to automatically cause the customer to receive mail addressed to the old address of the customer at the new address of the customer (see *col. 3 lines 1-65, 5 lines 10-54, 6 lines 6-7 line 52*).

As per claims 20, 80 and 142 Tsuei discloses the claimed method, wherein validating includes: determining whether the credit card information matches fraudulent credit card information stored on a database at the change of address server, and validating the identity when there is no match (see., abstract, col 5 *lines 10-54, 6 lines 6-7 line 52*).

9. As per claims 5, 7, 9-13, 15-19, 56-62, 64, 67, 69-73, 75-79, 116-122, 127, 129, 131-135, 137-141, 178-184 they do not further limit the inventive concept disclose in claim 4. Moreover their limitations are clearly taught in Tsuei's disclosure. Therefore they are rejected under the same rationale as claim 4.

RESPONSE TO ARGUMENTS

10. Applicant's argument with respect to claims 4-20, 55-64, 66-80, 115-122, 126-142 and 177-184 have been fully considered but they are moot in view of new ground (s) of rejection. Necessitated by amendment.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00. Hoteler.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pierre E. Elisca/
Primary Examiner, Art Unit 3621